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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,953

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Mary Rose Rice

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7896

7590  
Leon E. Redman  
Masco Corporation  
21001 Van Born Road  
Taylor, MI 48180

10/20/2008

EXAMINER

CASCHERA, ANTONIO A

ART UNIT

PAPER NUMBER

2628

MAIL DATE

DELIVERY MODE

10/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/748,953	<b>Applicant(s)</b> RICE, MARY ROSE	
	<b>Examiner</b> Antonio A. Caschera	<b>Art Unit</b> 2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10,12-15 and 45-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,12-15 and 50-66 is/are allowed.
- 6) ☒ Claim(s) 8,10 and 45-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1, 4 and 45 are objected to because of the following informalities:
  - a. In reference to claims 1 and 45, the citing of “color combination paint sample cards” or “color combination style cards” should be replaced with “physical color combination paint sample cards” and “physical color combination style cards” respectively, in order to maintain consistent language throughout the claims. Note, dependent claims should also be reviewed and changes made accordingly.
  - b. In reference to claim 4, the phrase, “...paint sample cards in column in the...” (see line 2) should read, “...paint sample cards in columns in the...”
  - c. In reference to claim 4, the phrase, “...the lease chromatic...” (see last 2 lines) should read, “...the least chromatic.”

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 45-49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim(s) 45-49 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be

Art Unit: 2628

performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. Note, although the claims do recite, “A method of displaying...in a two-dimensional physical display,” this is not seen as equivalent to say claim 1’s, “A method of displaying...in a two-dimensional physical display unit,” which is found to be statutory.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8, 10 and 45-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "the color combination paint sample card" in last 2 lines. There is insufficient antecedent basis for this limitation in the claim. Note, claim 10 inherently suffers from such an issue since they depends upon claim 8.

Art Unit: 2628

Claim 45 recites the limitation "the display unit" in line 5. There is insufficient antecedent basis for this limitation in the claim. Note, claims 46-49 inherently suffer from such an issue since they depend upon claim 45.

### ***Response to Arguments***

4. The addition of claims 54-66 is noted.

5. Applicant's arguments, see page 10 of Applicant's Remarks, filed 08/29/08, with respect to the objection of claim 8 have been fully considered and are persuasive. The objection of claim 8 has been withdrawn since informalities have been corrected for.

6. Applicant's arguments, see pages 10-14 of Applicant's Remarks, filed 08/29/08, with respect to the 35 USC 103 rejection of claims 1-4, 6 and 12-14 have been fully considered and are persuasive. The 35 USC 103 rejection of such claims has been withdrawn. Note, a prior art search has yielded no further applicable prior art as per prior art rejection purposes.

7. In regards to the analyzation of claims 1-6, 8, 10, 12-15 and 50-66 in view of 35 USC 101, the Office deems such claims as reciting statutory subject matter as the current practices and procedures of the Office deem the methods of claim 1 to at least be tied to another statutory class (such as a particular device of "display unit") and the systems and "units" of claims 8, 12, 50 and 60 to be implanted via physical/tangible components.

### ***Allowable Subject Matter***

8. Claims 1-6, 12-15 and 50-66 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Art Unit: 2628

In reference to claims 1 and 12, the prior art of record does not explicitly disclose arranging a first plurality of physical paint sample cards on a display unit so that they are arranged in groups of varying hue in a first direction and chroma in a second direction while further arranging one or more combination or coordination paint sample cards adjacent each group of different hue and chroma physical paint sample cards, each color combination or coordination paint sample card containing a plurality of paint samples having the same base hue as the hue of a group it is adjacent to with a picture of a building or room painted with the plurality of colors on the color combination paint sample card, in combination with the further limitations of claims 1 and 12 respectively. Note, claim 1 is also objected to for minor informalities which must be corrected for before any allowance of the application is performed.

In reference to claims 2-6, 54-56 and 11-15, 57-59, claims 2-6, 54-56 and 11-15, 57-59 depend upon allowable claims 1 and 12 respectively and are therefore also deemed allowable. Note, claim 4 is also objected to for minor informalities which must be corrected for before any allowance of the application is performed.

In reference to claim 50, the prior art of record does not explicitly disclose a first plurality of paint sample cards arranged in hue groups, arranging one or more color combination style cards adjacent to each group of different hue, each combination card having a tri-fold card with three separate sections, each section containing a plurality of paint samples and a picture of a room painted with the plurality of paint samples on the section, each section of the tri-fold card having a picture of a different room, in combination with the further limitations of claim 50.

In reference to claims 51-53, claims 51-53 depend upon allowable claim 50 and are therefore also deemed allowable.

Art Unit: 2628

In reference to claim 60, the prior art of record does not explicitly disclose a first plurality of physical color combination cards including a plurality of paint samples which includes at least a base hue sample and a plurality of complementary color samples arranged adjacent to the base hue sample and having a picture a room or building that is painted with the plurality of paint samples, in combination with the further limitations of claim 60.

In reference to claims 61-66, claims 61-66 depend upon allowable claim 60 and are therefore also deemed allowable.

9. Claims 8 and 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

In reference to claim 8, the prior art of record does not explicitly disclose a first plurality of physical paint sample cards, a second plurality of physical paint samples cards carrying a paint color of similar hue but different chroma to every other physical paint sample card of the second plurality and one or more physical color coordination paint sample cards adjacent to each chromatic group of the first and second plurality, including a picture of a building or room painted with the plurality of paint sample colors on the combination paint sample card, in combination with the further limitations of claim 8. Further note, claim 8 comprises a minor informality as described above but must be corrected for.

In reference to claim 10, claim 10 depends upon allowable claim 8 and is therefore also deemed allowable.

### ***Conclusion***

Art Unit: 2628

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Antonio Caschera whose telephone number is (571) 272-7781. The examiner can normally be reached Monday-Thursday and alternate Fridays between 7:00 AM and 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung, can be reached at (571) 272-7794.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**571-273-8300 (Central Fax)**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (571) 272-2600.

/Antonio A Caschera/

Examiner, Art Unit 2628

Temporary Full Signatory Authority

**10/19/08**